

REMARKS

Applicants have carefully considered the August 18, 2004 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-16 are pending in this application. In response to the Office Action dated August 18, 2004, claims 1-4 and 14-16 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed claims and disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification, including page 12, lines 4-7 of the present specification and page 24, lines 7-10 of the certified English translation of the priority document (JP 2001-045409) for the present application (copy attached hereto). *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (C.C.P.A. 1981).

Initially, Applicants note that the Examiner requested the publication date of the Windeler et al. reference (published 2/21/1999) cited on the PTO-1449 submitted on June 23, 2004. Applicants note that this reference was previously cited by Applicants in their Information Disclosure Statement filed on May 7, 2002 and was considered by the Examiner on March 25, 2004.

Claims 1-15 were rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully traverse the rejection in view of the foregoing amendments to claims 1, 4, 14, 15 and 16. Applicants submit that the amendment to the pending claims addresses the Examiner's antecedent basis concerns. Accordingly, the Examiner is requested to reconsider and withdraw the rejection under the second paragraph of 35 U.S.C. § 112.

Claims 1, 3-5, 12 and 14-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa et al. (U.S. Patent No. 6,526,209, hereinafter "Hasegawa") in view of Fajardo (WO 2000/16141, hereinafter "Fajardo"), Turpin et al. (U.S. Patent No. 5,167,684, hereinafter "Turpin") and/or Fleck et al. (U.S. Patent No. 3,622,291, hereinafter "Fleck"). Applicants respectfully traverse the rejection.

Claims 1-9, 12, 14-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa in view of Fajardo Turpin and/or Fleck and in further in view of Berkey et al. (U.S. Patent No. 5,152,818, hereinafter "Berkey"). Applicants respectfully traverse the rejection.

Claims 10-11 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa in view of Fajardo Turpin and/or Fleck and in further in view of Berkey and further in view of Yokota et al. (U.S. Patent No. 4,793,842, hereinafter "Yokota"). Applicants respectfully traverse the rejection.

Although Applicants disagree that the claimed inventions are obvious predicated upon Hasegawa in view of the secondary references, to expedite prosecution of the Application, Applicants submit that the reference to Hasegawa cannot be properly applied against the present Application under 35 U.S.C. § 103. According to 35 U.S.C. § 103(c), and as discussed in M.P.E.P. § 2146, subject matter that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the subject matter and the claimed invention were at the time the invention was made, owned by the same person or subject to our obligation to assignment of the same person.

The cover page of U.S. Patent No. 6,526,209 to Hasegawa indicates that this Patent was assigned to Sumitomo Electric Industries, Ltd. of Osaka, Japan. Under M.P.E.P. § 702.02(l), common ownership at the time the later invention was made can be evidenced by referring to an

assignment which is recorded in the Patent and Trademark Office in accordance with 37 C.F.R. Part 3. The Assignment of Application No. 10/076,603 (the present Application) to Sumitomo Electric Industries, Ltd. of Osaka, Japan was executed on March 26 and March 27, 2002. This Assignment was recorded in the U.S. Patent and Trademark Office on May 7, 2002, and the Assignment appears at Reel 012880, Frame 0660.

Therefore, the subject matter disclosed by Hasegawa and Applicants' claimed inventions were commonly owned at the time the invention was made or subject to an obligation of assignment to the same person, i.e., Sumitomo Electric Industries, Ltd. of Osaka, Japan. As such, under 35 U.S.C. § 103(c), the reference to Hasegawa cannot be considered by the Examiner when determining whether Applicants' inventions are obvious under 35 U.S.C. § 103. Moreover, the secondary references, alone or in combination fail to teach the claimed inventions as a whole. Accordingly, the rejections under 35 U.S.C. § 103 are not legally viable and the Examiner is requested to reconsider and withdraw the rejections over the pending claims.

The Examiner's attention is directed to the Hasegawa's (U.S. Patent No. 6,526,209) corresponding PCT published application (WO 01/79902 A1). The corresponding PCT published application is provided in an accompanying Information Disclosure Statement for the Examiner's consideration. It is noted that the publication date of the PCT published application is October 25, 2001. To the extent that the Examiner would be inclined to apply a prior art rejection based on this corresponding PCT published application, Applicants submit herewith, a copy of the certified English translation of the priority document (JP 2001-045409) for the present application. The filing date of the priority document is February 21, 2001, which predates the PCT published application.

It is believed that pending claims 1-16 are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



Brian K. Seidleck
Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
202.756.8000 BKS:apr
Facsimile: 202.756.8087
Date: November 18, 2004